

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed May 3, 2004. Claims 1-16, 18-49, and 51-59 are pending in this application. In the Office Action, Claims 1-16, 10-16, 18-24, 26-30, 32-39, 43-49, and 51-59 were rejected and Claims 7-9, 25, 31, and 40-42 stand rejected. Applicants have amended Claims 1, 22, 28, and 34. Applicants submit that no new matter has been added with these amendments. For at least the reasons discussed below, Applicants respectfully request reconsideration and full allowance of all pending claims.

Section 103 Rejections

The Examiner rejects Claims 1-2, 10-16, 18-24, 26-30, 32-35, 43-49, and 51-59 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,266,343 issued to Caves ("Caves") in view of U.S. Patent No. 6,438,137 issued to Turner, et al. ("Turner"). In addition, the Examiner rejects Claims 3-6 and 36-39 under 35 U.S.C. § 103(a) as being unpatentable over *Caves* in view of *Turner* as applied to Claims 1 and 34, and further in view of U.S. Patent No. 6,351,471 issued to Robinett, et al. ("Robinett"). Applicants respectfully traverse all rejections therein.

In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations.¹ Applicant notes that the Examiner has failed to satisfy at least two of the elements of non-obviousness, which are required to support a proper §103 analysis.

A. *Caves, Turner, and Robinett* Fail to Disclose, Teach or Suggest Each and Every Element of Claims 1-16, 18-49, and 51-59

1. Claims 1, 22, 28, and 34 are Allowable Over the Cited References

Claim 1, as amended, recites, "mixing the data segments from two or more of the telephony devices to create an aggregate data segment, wherein each data segment has a first length and the aggregate data segment also has the first length." In order to facilitate the

¹ See M.P.E.P. § 2143.

examination of the present Application, Applicants amended Claim 1 to merely clarify the previous claim language. Prior to these amendments, the Examiner offered the CPS packets and the CPS-PDUs disclosed in *Caves* as data segments and aggregate data segments, respectively. Office Action, Page 2. *Caves* teaches that that one or more CPS packets are concatenated to form a CPS-PDU. Col. 3, Lines 46-49. As is well known in the art, concatenating combines several items in a end-to-end manner. As a result, the CPS-PDU has a length that is equal to the combined length of the CPS packets, not the length of a single CPS packet. (See also Figure 2). Therefore, *Caves* fails to teach or suggest that "each data segment has a first length and the aggregate data segment also has the first length."

In addition, Claim 1, as amended, recites "constructing an outgoing payload section for one or more of the telephony devices by linking successively generated aggregate data segments." For the teaching of this limitation, the Examiner offers a passage in *Caves* that teaches reconverting adapted data from a second to a first format. However, the Examiner fails to illustrate how this passage relates to the CPS-PDUs that the Examiner offers as teaching the claimed aggregate data segments. In addition, the Examiner fails to illustrate how this passage teaches that successively generated CPS-PDUs are linked to construct an outgoing payload. Assuming, for the sake of argument, that *Caves*' CPS packets are combined in a CPS-PDU to form an "aggregate data segment," the CPS-PDU comprises the entire payload section of the packet. Therefore, the *Caves* payload is constructed of, at best, a single aggregate data segment, rather than being constructed by linking successively generated aggregate data segments, as recited in amended Claim 1. Accordingly, Applicants submit that Claim 1 and its dependents are patentably distinct from the *Caves-Turner* combination.

Independent Claims 22, 28, and 34 recite limitations that are similar, although not identical, to the limitation of Claim 1 discussed above. Therefore, these claims are allowable for reasons analogous to those discussed above in connection with Claim 1. Claims 23-24, 26-27, 29-30, 35, and 43-47 each depend from one of independent Claims 22, 28, and 34 and are thus also patentable over the cited art.

2. Claims 15, 48, and 55 are Allowable over the Cited References

Claim 15 recites "dividing a first payload section of a first incoming packet into one or more full segments of equal size and a remainder segment containing the remainder of the

first payload section.” For the teaching of this limitation, the Examiner states, “Because variable length packets, from different users, are segmented to fit into a fixed length packet, some packets from the user must have a remainder and the remainder will be mixed with full segments to form an aggregate packet.” Office Action, Page 6. However, Applicants submit that Figure 2 of *Caves* merely teaches encapsulating, and the Examiner fails to cite any passage that teaches that segmenting occurs during the encapsulation process. In particular, *Caves* discloses that the user information packets illustrated in Figure 2 are encapsulated into SSCS-PDUs. Col. 3, Lines 18-20. The SSCS-PDUs are themselves encapsulated in CPS packets by the addition of CPS packet headers. Col. 3, Lines 34-36. Next, the CPS packets, as discussed above, are concatenated into the fixed-length CPS-PDUs. Col. 3, Lines 46-48. Even though the CPS-PDUs are a fixed length, there are numerous ways to generate a fixed-length packet from variable length packets without segmenting. For instance, smaller packets may be encapsulated in larger packets with remaining space filled with space holders. Thus, Applicants submit that the Examiner fails to cite any passage in *Caves* that teaches or suggests dividing a payload section into full segments and a remainder segment as claimed in the Application. Accordingly, Applicants submit that Claim 15 and its dependents are patentably distinct from the *Caves-Turner-Robinett* combination.

For at least this reason, amended Claims 48 and 55 are allowable over the cited references. Therefore, Applicants respectfully request reconsideration and allowance of amended Claims 48 and 55, as well as all claims that depend from these claims.

B. No Motivation or Suggestion to Combine *Caves*, *Turner*, and *Robinett*

The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art” at the time of the invention.² The “fact that references can be

² M.P.E.P. § 2143.01.

combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification.³

The governing Federal Circuit case law makes this strict legal standard even clearer.⁴ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding.”⁵ “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.”⁶ However, the “range of sources available . . . does not diminish the requirement for actual evidence.”⁷ In *In re Dembicza*k, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.⁸

In the present case, the Examiner is improperly using the Applicants' disclosure as a blueprint for piecing together various elements of *Caves*, *Turner*, and *Robinett*. For example, the Examiner merely stated that at the time the present invention was made, it would have been obvious for one of ordinary skill in the art to combine the teachings of *Caves*, *Turner*, and *Robinett* “in order to maintain the bit rate and prevent buffer underflow.” Office Action,

³ *Id.* (emphasis in original).

⁴ Note M.P.E.P. § 2145(X)(C) (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

⁵ *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)).

⁶ *In re Dembicza*zak, 175 F.3d 994, 999 (Fed. Cir. 1999).

⁷ *Id.*

⁸ 175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted); *see also In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.).

Page 5. The Examiner has not provided any evidence of a teaching, suggestion, or motivation to combine the references.

In fact, *Robinett* teaches away from the claimed invention.⁹ Claim 4 recites "inserting one or more silence placeholders to fill a time interval during which no incoming media packets are received from a particular telephony device." Claim 37 recites similar, although not identical, limitations. Claims 5-6 and 38-39, which depend on Claims 4 and 37, respectively, also recite the use of silence placeholders. Although *Robinett* discloses that empty packets are sometimes found in data streams, the reference actually teaches away from inserting "silence place holders" into data packets. *Robinett* specifically notes that "it is desirable to reduce the number of such bandwidth wasting null packets." (*Robinett*, Col. 39, Lines 62-64). In fact, *Robinett* is directed toward an invention that replaces null packets with data packets. (*Robinett*, Col. 39, Line 66 – Col. 40, Line 3). Consequently, a person of skill in the art would not be motivated to insert empty packets into the data streams disclosed in *Caves* or *Turner* because *Robinett* is directed toward a system and method for replacing null packets with data packets and teaches that inserting empty packets into data streams is undesirable (*Robinett*, Col. 39, Line 61 – Col. 40, Line 2).

Consequently, a *prima facie* case of obviousness cannot be maintained with respect to Claims 1-16, 18-49, and 51-59, as the Examiner has not shown the requisite proof necessary to establish a suggestion or motivation to combine the cited references. For at least this reason, Applicants respectfully request reconsideration and allowance of Claims 1-16, 18-49, and 51-59.

Allowable Subject Matter

Claims 7-9, 25, 31, and 40-42 are objected as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, Claims 7-9, 25, 31, and 40-42 depend from one of allowable independent Claims 1, 22, 28, and 34 as shown above. Accordingly, Applicants have not so amended Claims 7-9, 25, 31, and 40-42 at this time.

⁹ See M.P.E.P. § 2144.05 (III).

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Although Applicants believe that no fees are due, the Commissioner is hereby authorized to charge additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker & Botts, L.L.P.

Respectfully submitted,

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